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NOV 25 2005

OFFICE OF PETITIONS

In re Application of	:	DECISION ON
Timothy Breeden and Doug Dew	:	PETITIONS UNDER
Application No. 10/733,989	:	37 CFR 1.181
Filed: December 11, 2003	:	AND REFUSING
Title of Invention:	:	STATUS UNDER
SYSTEM AND METHOD FOR SOFTWARE	:	37 CFR 1.47(a)
APPLICATION DEVELOPMENT IN A PORTAL	:	
ENVIRONMENT	:	

This is in response to the Request for Reconsideration of Petition Under 37 CFR 1.47(a) to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor(s), and the Petition to Withdraw Holding of Abandonment Under 37 CFR 1.181(a). Both petitions were filed November 9, 2005. The three (3) month extension of time request is hereby granted.

The petition under 37 CFR 1.181 is granted.

The petition under 37 CFR 1.47(a) is dismissed.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)", and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

Background

The above-identified application was filed on December 11, 2003, without a fully executed oath or declaration. The Office mailed a Notice to File Missing Parts of Nonprovisional Application

(hereinafter "Notice"), on April 27, 2004, requiring *inter alia*, an executed oath or declaration.

In response to the Notice, Applicant filed a petition on September 30, 2004 under 37 CFR 1.47(a), to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventors.

In support of the petition the Applicant filed a Declaration Under 37 CFR §1.47 on Behalf of Signing Inventors in Support of Petition to Accept Declaration in Response to a Missing Parts Without the Signature of a Joint Inventor, executed by Karl F. Kenna, wherein Mr. Kenna declared that formal papers, "namely a Declaration for Patent Application and an Assignment" were sent to the nonsigning inventor via email and via Federal Express, and have not been returned. Kenna Declaration at p.2.

The petition was dismissed in a decision mailed October 25, 2004, for failing to meet the requirements of a grantable petition under 37 CFR 1.47(a). Applicant was advised that "[b]efore an inventor can refuse to sign an oath or declaration, he must have been *presented with a copy of the application papers (specification, claims and drawings)*. See MPEP 409.03(d)." October 25, 2004 Decision Dismissing Petition at pp.2-3. Applicant was further advised that "Applicant must present a copy of the application papers to the inventor." Id.

Finally, the petition noted that the "[a] review of the oath or declaration filed with the instant petition reveal[ed] that the citizenship of inventor Dew [wa]s missing from the declaration. An oath or declaration that includes the inventor's citizenship is required." October 25, 2004 Decision Dismissing Petition at p.3.

The April 27, 2005 Request for Reconsideration

Applicant filed a Request for Reconsideration on September 30, 2005, and provided that Applicant learned of inventor Dew's new home address "in Champaign, Illinois, and subsequently Applicant's attorney sent a follow-up letter via FedEx. Copies of the letter and tracking receipt showing delivery on August...27, [2]004 [we]re attached..." Reconsideration Request at p.3.

A review of the letter revealed that the letter referenced the Declaration and Assignment in the first paragraph, and stated that "[for your convenience, we are enclosing another set of documents...." The letter then requested, in the second paragraph, that Applicant review the Declaration and Assignment and execute the documents. The third paragraph requested a return of the original documents in a self-addressed envelope provided by Applicant. There was no mention in the letter that a copy of the above-identified application had been included with the letter.

Applicant further provided that several emails were sent to inventor Dew; however, Applicant learned after the last of the emails had been sent, that "the host name could not be found." Reconsideration Request at p.3.

Applicant concluded with the assertion that a diligent effort has been made in an attempt to contact inventor Dew. Reconsideration Request at p.4.

Applicant also filed several copies of the oath/declaration; however, none of the Declarations were been corrected to include the citizenship of the nonsigning inventor.

The Request for Reconsideration was dismissed in a Decision mailed June 6, 2005. Applicant was advised that (1) he must demonstrate that he has presented a copy of the application papers to the inventor, and (2), that an oath or declaration that includes the inventor's citizenship is required.

This Office subsequently mailed a Notice of Abandonment on September 8, 2005, informing Applicant that the application was held abandoned for failing to timely and properly reply to the June 6, 2005 Decision dismissing the Reconsideration Request.

Petition to Withdraw Holding of Abandonment

Applicant petitions to withdraw the holding of abandonment and asserts that the maximum extendable period for reply has not yet expired.

Applicant is correct. The June 6, 2005 Decision dismissing the Reconsideration Request provided for extensions of time under 37 CRR 1.136(a). As such, Applicant was given five (5) months

of extensions of time, in addition to the two (2) month period for reply set forth in the Decision. Applicant's second Request for Reconsideration was filed November 9, 2005, and includes the fee for a three (3) month extension of time. Accordingly, the petition is timely filed and the holding of abandonment is improper.

Accordingly, the holding of abandonment is hereby withdrawn.

The instant second Request for Reconsideration

Applicable Law

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks item (2).

As to item (2), Applicant has failed to provide an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116. A review of the oath or declaration filed with the instant petition reveals that it is unexecuted. The citizenship of inventor(s) must be provided in the oath or declaration under 37 CFR 1.63. Accord 37 CFR 1.63 and MPEP 601(I). Applicant has yet to file an oath or declaration executed by the available inventors with the signature block of the nonsigning inventor left blank. Accord 37 CFR 1.47(a) and MPEP 409.03. The executed oath/declaration filed with the instant petition is unexecuted.

An oath or declaration, executed by the available inventor(s) with the signature block of the nonsigning inventor left blank, that includes the inventor's citizenship is required¹.

¹ When an inventor who executed the original declaration is refusing or cannot be found to execute a required supplemental declaration, the requirement for that inventor to sign the supplemental declaration may be suspended or waived in accordance with 37 CFR 1.183. All available joint inventor(s) must sign the supplemental declaration on behalf of themselves, if appropriate, and on behalf of the nonsigning inventor. See MPEP § 409.03(a). If there are no joint inven-tor(s), then the party with sufficient proprietary interest must

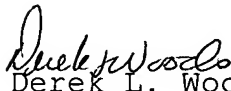
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.


Derek L. Woods
Attorney
Office of Petitions

sign the supplemental declaration on behalf of the nonsigning inventor. See
MPEP § 409.03(b).